

Application No. 10/083,178
Amendment dated January 19, 2004
Reply to Office Action of Office Action Mailed Oct. 17, 2003
Attorney Docket No. 01-10416

REMARKS/ARGUMENTS

Claims 1 - 16 remain in this application. Claims 18 - 21 have been withdrawn without prejudice to any future or pending application covering the same or similar subject matter. Dependant Claims 22 - 24 have been added. No new matter has been added to this application by way of any of the foregoing amendments.

Specification

In paragraph 1 of the Office Action the examiner objected to the underlining of headings. Please remove the underlining of the headings. The applicant thanks the examiner for this suggestion.

Claim Objections

In paragraph 2 of the Office Action, the examiner objected to Claim 1, Line 2 as having an extra space. Please remove one of the spaces between "box" and "structure" in Line 2 of Claim 1. The applicant thanks the examiner for this suggestion.

In paragraph 3 of the Office Action, the examiner objected to Claim 12 as depending from itself. Applicant has amended Claim 12 to depend from Claim 11, thereby correcting this informality. The applicant thanks the examiner for this suggestion.

In paragraph 4 of the Office Action, the examiner objected to the numbering of claims. The applicant has changed the number of original Claim 17 to 16 to correct this informality. The applicant thanks the examiner for this suggestion.

Claim Rejections Under 35 U.S.C. §103(a)

In paragraph 6 of the Office Action, the Examiner rejected claims 1-3, 5, and 8-10 under 35 U.S.C. §103(a) as being unpatentable over Heifetz (US 3,778,528) in view of Nielsen (US 4,974,376).

It is respectfully submitted that the Examiner has not established a prima facie case of obviousness. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the Examiner to provide some suggestion of the desirability of doing what it is the inventor has done. "To support the conclusion the claimed invention is

Application No. 10/083,178
Amendment dated January 19, 2004
Reply to Office Action of Office Action Mailed Oct. 17, 2003
Attorney Docket No. 01-10416

directed to obvious subject matter, either the references expressly or implicitly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why an artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App.& Inter. 1985).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success are not both found in the prior art, and the combination thereof does not contain all recited elements. In reference to Claim 1 nowhere does the Heifetz (US 3,778,528) or Nielsen (US 4,974,376) references show, disclose, claim, or teach or suggest at least a second interior volume for storage of human belongings, or a box structure specially configured for securing together a plurality of similar modular structures as required by Claim 1 of the present application.

Applicant submits that Claim 1 is allowable over Heifetz and Nielsen and respectfully requests it be allowed. Because Claims 2-3, 5, and 8-10 depend from allowable Claim 1, Applicant submits that they are also allowable.

In paragraph 7 of the Office Action, the Examiner rejected claims 6, 7, 11, 12, and 16 under 35 U.S.C. §103(a) as being unpatentable over Heifetz in view of Nielsen and further in view of Shane (US 5,638,646). As to Claims 6, 7, 11, and 12, all depend from independent Claim 1 and therefore include all of the limitations of Claim 1. In reference to Claim 1 nowhere does the Heifetz, Nielsen or Shane references show, disclose, claim, or teach or suggest at least a second interior volume for storage

Application No. 10/083,178
Amendment dated January 19, 2004
Reply to Office Action of Office Action Mailed Oct. 17, 2003
Attorney Docket No. 01-10416

of human belongings, or a box structure specially configured for securing together a plurality of similar modular structures as required by Claim 1 of the present application.

In reference to Claim 16 nowhere does the Heifetz, Nielsen or Shane references show, disclose, claim, or teach or suggest all of the recited elements required by Claim 16 of this application. Namely, the references do not show at least exterior sidewalls extending to an opposing end in combination with a bulkhead defining a second interior volume, or where the exterior walls specially configured for securing together a plurality of said modular shelter units as required by Claim 16 of the present application. For these reasons, Applicant submits that Claim 16 is allowable over Heifetz, Nielsen, and Shane and respectfully requests it be allowed.

In paragraph 8 of the Office Action, the Examiner rejected claims 4 and 14 under 35 U.S.C. §103(a) as being unpatentable over Heifetz in view of Nielsen and further in view of Jazzar (US 5,081,805). Claims 4 and 14 both depend from independent Claim 1 and therefore include all of the limitations of Claim 1. In reference to Claim 1 nowhere does the Heifetz, Nielsen or Jazzar references show, disclose, claim, or teach or suggest all of the recited elements required by Claim 1 of this application. Namely, the references do not show either a second interior volume for storage of human belongings, or a box structure specially configured for securing together a plurality of similar modular structures as required by Claim 1 of the present

Application No. 10/083,178
Amendment dated January 19, 2004
Reply to Office Action of Office Action Mailed Oct. 17, 2003
Attorney Docket No. 01-10416

application. Because Claims 4 and 14 depend from allowable Claim 1, Applicant submits that they are also allowable.

Furthermore the examiner has failed to establish that one of ordinary skill in the art would consider combining the Jazzer reference with Heifetz and Nielsen as Jazzer is in a non-analogous art, namely precast concrete.

In paragraph 9 of the Office Action, the Examiner rejected claims 13 and 15 under 35 U.S.C. §103(a) as being unpatentable over Heifetz in view of Nielsen and further in view of Sanford (US 6,179,522). Claims 13 and 15, both depend from independent Claim 1 and therefore include all of the limitations of Claim 1. In reference to Claim 1 nowhere does the Heifetz, Nielsen or Sanford references show, disclose, claim, or teach or suggest either a second interior volume for storage of human belongings, or a box structure specially configured for securing together a plurality of similar modular structures as required by Claim 1 of the present application. Because Claims 13 and 15 depend from allowable Claim 1, Applicant submits that they are also allowable.

Furthermore, Sanford may show a corner fitting 103, but it does neither show, teach or suggest a ventilating means as required by Claim 13 of this application, nor show, teach or suggest raised bosses at the corners and edges of the box structure as required by Claim 15 of this invention. For these reasons, the Applicant submits that Claims 13 and 15 are allowable and respectfully requests they be allowed.

Application No. 10/083,178
Amendment dated January 19, 2004
Reply to Office Action of Office Action Mailed Oct. 17, 2003
Attorney Docket No. 01-10416

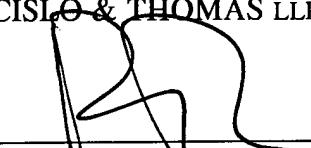
Conclusion

Having responded to each of the Examiner's concerns, Applicant asserts that the application is now in condition for allowance and solicits such action. If a telephone interview will advance the allowance of the application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicant requests the Examiner contact Applicant's representative at the number listed below.

It is not believed that any additional fees are due; however, in the event any additional fees are due, the Examiner is authorized to charge Applicant's attorney's deposit account no. 03-2030.

Respectfully submitted,

CISLO & THOMAS LLP



Robert J. Lauson
Reg. No. 41,930

Date: January 19, 2004

Enclosure

Certificate of First Class Mailing
Acknowledgement Postcard

CISLO & THOMAS LLP
233 Wilshire Boulevard, Suite 900
Santa Monica, California 90401
Tel: (310) 451-0647
Fax: (310) 394-4477
www.cislo.com

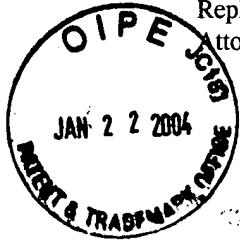
Z:\TMDOCS\01-10416\01-10416 RESPONSE TO OFFICE ACTION.DOC

Application No. 10/083,178
Amendment dated January 19, 2004
Reply to Office Action of Office Action Mailed Oct. 17, 2003
Attorney Docket No. 01-10416



25189

PATENT TRADEMARK OFFICE



CERTIFICATE OF FIRST CLASS MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an enveloped addressed as follows:

Mail Stop NON-FEE AMENDMENT
Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

on _____

JAN. 20, 2004

Robert J. Lauson Reg. No. 41930

JAN. 20, 2004

Date

RECEIVED

JAN 28 2004

GROUP 3600